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10/607,184	06/26/2003	David L. Patton	83891AF-P	6177

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EXAMINER

LE, BRIAN Q

ART UNIT PAPER NUMBER

2623

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,184

Applicant(s)

PATTON ET AL.

Examiner

Brian Q Le

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/26/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2-5, and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 2, the Applicant must provide **two separate supports** in the original disclosure for a method wherein said micro-discrete indicia is located initially located using an eye-drop **and** a microscope and for another method wherein said micro-discrete indicia is located initially located using an eye-loop **or** a microscope. Similarly, the same rejections are made for claims 5 and 7 because of its **and/or** limitation.

Claims are not specifically addressed depend from indefinite antecedent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kaplan U.S. Patent No. 6,211,484 and further in view of Kurihara et al.

Art Unit: 2623

“Fabrication of Functional Probes for Near-field Optic Microscopy”, Lasers and Electro-Optics, 1997 pages: 148-149.

Regarding claim 1, Kaplan teaches a method for reading a micro-discrete indicia (comparison between reading indicia and retrieved metric at micron scale) (column 8, lines 50-55 and column 16, lines 45-50) on gemstone (column 1, lines 13-15) comprising the locating said micro-discrete indicia on said gemstone (measuring gemstone's characteristics and locating indicia by coordinate) (column 8, lines 50-65 and column 4, lines 45-50). However, Kaplan does not explicitly teaches the reading of micro-discrete indicia using near-field optics. Kurihara teaches a material measurement (material reading)/polymer utilizing near-field optical microscopy (page 148, 2nd column, first 2 paragraphs). Modifying Kaplan's method of providing micro-discrete indicia on gemstone would able to provide the reading (measurements) of micro-discrete indicia using near-field optics. This would improve processing and therefore, it would have been obvious to one of the ordinary skills in the art to modify Kaplan according to Kurihara.

Art Unit: 2623

Regarding claim 2, Kaplan teaches a method wherein said micro-discrete indicia is located (as discussed) initially located using an eye-loop (jeweler's loupe) (column 8, lines 30-35) and/or microscope (FIG. 6, element 68).

For claim 3, Kaplan further teaches a method wherein said micro-discrete indicia is located by using predetermined coordinates (initially positioned) associated with the characteristics of said gemstone (column 4, lines 48-60).

Referring to claim 4, Kaplan also teaches a method where a document (column 8, lines 14-18 and column 4, lines 13-21) is provided that designates the appropriate coordinates of the micro-discrete indicia of said gemstone (column 4, lines 48-60).

Regarding claim 5, Kaplan teaches a method wherein said characteristics of said gemstone is selected from of the following size (column 13, lines 31-37).

For claim 6, Kaplan discloses a method wherein said micro-discrete indicia is used for authenticating an occasion of said gemstone (column 13, lines 34-47).

Referring to claim 7, Kaplan teaches a method wherein said authentication identifies the quality and/or type of gemstone (face value) (column 6, lines 60-64).

For claim 8, Kaplan further teaches the scanning said gemstone (microscope scans gemstone) (FIG. 6, element 68).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Art Unit: 2623

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-2, and 5-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6-7, 9, and 16-18 of U.S. Patent No. 6,624,385 Patton et al. in view of Kurihara et al. "Fabrication of Functional Probes for Near-field Optic Microscopy", Lasers and Electro-Optics, 1997 pages: 148-149.

The patent's claim 1 is a method, which includes reading micro-discrete indicia by locating (selecting) and forming micro-discrete indicia using near-field optics on said gemstone rendered in the instant claim. Essentially the instant claim has a broader recitation of the invention of claim 1 of the patent, while lacking the reading of micro-discrete indicia. However, Kurihara teaches a material measurement (material reading)/polymer utilizing near-field optical microscopy (page 148, 2nd column, first 2 paragraphs). Modifying Patton's method of providing micro-discrete indicia on gemstone would be able to provide the reading (measurements) of micro-

Art Unit: 2623

discrete indicia using near-field optics. This would improve processing and therefore, it would have been obvious to one of the ordinary skills in the art to modify Patten according to Kurihara.

For claim 2 of the application, Kurihara further teaches the usage of microscope the measurement/reading (FIG. 1). Thus it would have been obvious for one skilled in the art to use a microscope to locate micro-discrete indicia.

Regarding claim 5 of the application, the patent's claim 9 is a method, which includes a method wherein said characteristics of said gemstone (micro-discrete indicia is gemstone characteristics) is selected from size rendered in the instant claim.

Regarding claim 6 of the application, the patent's claims 6-7 is a method, which includes a method where in said micro-discrete indicia is used for authentication of gemstone rendered in the instant claim.

Regarding claim 7 of the application, the patent's claims 6, and 16-18 is a method, which includes a method discloses the authentication identifies the manufacturer, owner, retailer (business establishment), quality, and/or type of gemstone rendered in the instant claim.

Regarding claim 5 of the application, (as discussed in claim 2) Kurihara further teaches the usage of microscope the measurement/reading (FIG. 1). Thus, the microscope would provide the scanning of gemstone.

CONCLUSION

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to micro-discrete reading and near-field optics on objects:

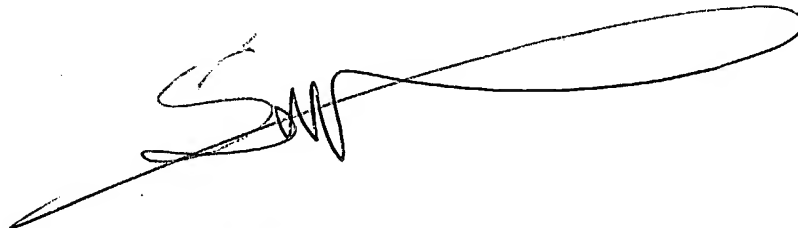
U.S. Pat. No. 5,393,976 to Koike, teaches method for displaying sample image using micro-discrete.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q Le whose telephone number is 703-305-5083. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC Customer Service whose telephone number is 703-306-0377.

BL
September 23, 2004

A handwritten signature in black ink, appearing to read 'SAMIR AHMED', with a large, sweeping loop at the end.

**SAMIR AHMED
PRIMARY EXAMINER**